

**REMARKS**

Reconsideration of the Office action mailed on December 17, 2004 in connection with the above-identified patent application is requested in view of the foregoing amendments and the following remarks.

**Special Circumstances**

The Examiner asked applicant to point out any material information from co-pending applications listed as parents to the instant application if the criteria for materiality applies and if the examination record provides reason for applicant to believe that the Examiner has not considered such information. Applicant has previously identified applications and believes that identification satisfies the duty of disclosure. Applicant is also attaching an updated list of applications and patents to this document. The Examiner is requested to inform applicant if further information is needed.

**Double Patenting**

The Examiner made several double patenting rejections, each of which is addressed below.

**1. Application Number 10/051,782.**

The Examiner provisionally rejected claims 25, 26 and 36-38 under the judicially created doctrine of obviousness-type double patenting in light of claims 1, 4-5, 7 and 20-35 from application number 10/051,782.<sup>1</sup> This rejection is traversed because a two-way test for obviousness should have been applied.

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<sup>1</sup> Application 10/051,782 has now issued as U.S. Patent No. 6,877,410.

Section 804(II)(B)(1)(b) from the MPEP explains:

[W]here, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office.

This rule is taken from the case of In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). In that case, the Board of Patent Appeals and Interferences affirmed an obviousness-type double patenting rejection of an earlier-filed application in view of a commonly-assigned but later-filed patent. Both the application and the patent concerned optical record carriers such as CDs. The Board applied a one-way test for obviousness and determined that the claims at issue from the earlier-filed application were obvious in light of claims from the later-filed patent. The Federal Circuit reversed and explained that a two-way test should have been applied because the two applications could not have been filed together as one, because it was not applicant's fault that the later-filed application issued first, and because the later-filed claims were not obvious in light of the earlier-filed claims. Id. at 594, 19 USPQ2d at 1293. The court explained that the rationale behind the application of the two-way test "is that an applicant (or applicants), who files applications for basic and improvement patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control." Id. at 593, 19 USPQ2d at 1292 (citing 3 D. Chisum, *Patents*, §9.03[2][c] (1990), and the following cases: In re Borah, 345 F.2d 1009, 148 USPQ 213 (CCPA 1966), In re Stanley, 214 F.2d 151, 102 USPQ 234 (CCPA 1954), In re Calvert, 97 F.2d 638, 38 USPQ 184 (CCPA 1938), Thomson-Houston Elec. Co. v. Elmira & Horseheads Ry. Co., 71 F. 396 (2d Cir.), *cert. denied* 163 U.S. 685, 16 S.Ct.

1201, 41 L.Ed.2d 315 (1896), Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 F. 712 (6<sup>th</sup> Cir. 1897)).

The case of In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), further explains when a two-way test applies. In Berg, the Federal Circuit affirmed a one-way double patenting rejection of genus claims in light of nearly identical species claims. The claims concerned a method of preparing abrasive particles for use as an abrasive grit. The genus and species claims were the subject of two separate applications filed the same day. The species claims issued first and the Patent Office applied a one-way test to reject the genus claims in light of the species claims. The court affirmed the double patenting rejection and the application of the one-way test because Berg could have filed all the claims in a single application but instead chose to file two separate applications on the same day. Id. at 1433, 46 USPQ2d at 1230.

Even though Berg affirmed the application of the one-way test, the court recognized that the two-way test applies when a later-filed improvement patent issues before an earlier-filed basic invention. Specifically, the court distinguished Braat by saying: “Braat ... emphasized the more typical scenario in which, despite common inventive entities, the two-way test applied: ‘when a later-filed improvement patent issues before an earlier filed basic invention.’” Id. at 1434, 46 USPQ2d at 1230 (quoting In re Braat, 937 F.2d at 593, 19 USPQ2d at 1292, emphasis added in Berg). The court in Berg also said the “essential concern” behind the two-way test “was to prevent rejections for obviousness-type double patenting when the applicants filed first for a basic invention and later for an improvement, but, through no fault of the applicants, the PTO decided the applications in reverse order of filing, rejecting the basic application

although it would have been allowed if the applications had been decided in the order of their filing." Id. at 1432, 46 USPQ2d at 1229. These statements confirm that the two-way test applies when a later-filed improvement patent issues before an earlier-filed application through no fault of applicant.

The situation in the present application is the same as in Braat and as described in Berg, and therefore, the two-way test for obviousness should apply. The present application was filed before the cited patent and the cited patent could not have been filed with the present application because it includes additional disclosure of later-developed material. It is not applicant's fault that the cited patent issued first. Also, the cited claims from the later-filed patent are not obvious in light of the earlier-filed claims.

The Examiner, however, applied a one-way test because he said administrative delay is required for a two-way test and there has been no administrative delay. Specifically, the Examiner said: "The office did not prevent the earlier filed application from issuing nor did the office prevent the earlier application from being prosecuted. It should be noted that normal prosecution of an application does not constitute delaying. Therefore, only a one-way test is required." (Office action, 10.)

Saying administrative delay is required for the two-way test is another way of saying the two-way test applies if the administrative process, and not some action taken by the applicant, delayed issuance of the first-filed application until after issuance of the later-filed application. In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233. If the delay was no fault of applicants, or in other words, if applicant did not take some action to delay the issuance of the first application, then the Patent Office (i.e., the administrative process) is responsible for the delay. However, if applicant took some action to delay

the issuance of the first application until after the second patent issues, then a one-way test may be appropriate. Id.

The cases of Braat and Berg illustrate this point. In Braat the Federal Circuit applied the two-way test because it was "not [applicant's] fault that the combination claims in the [subsequent] patent issued first." Braat, 937 F.2d at 594, 19 USPQ2d at 1293. Applicant did not act to delay the issuance of the first application. In Berg the Federal Circuit did not decide whether there was delay, but gave the following examples of how an applicant could delay the issuance of a first-filed application: "filing the genus claims long after the species claims even though the two were invented at nearly the same time or the genus claims were invented first, or by filing numerous continuations in the genus application while failing to respond substantively to PTO Office actions." In re Berg, 140 F.3d at 1434 n.6, 46 USPQ2d at 1231 n.6 (citing In re Emert, 124 F.3d 1458, 1461, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997)).

The present application is similar to Braat because applicant did not act to delay the issuance of the first application. The present application was filed first, before the cited application. The cited application was filed over fifteen months after the present application as a continuation-in-part to the present application (and to other applications). Also, the present application is not the result of multiple continuation applications, and applicant has responded substantively and promptly to each Office action. Thus, none of the acts identified in Berg by which an applicant may delay prosecution are found in the present application. On the other hand, the Patent Office did not issue a first action in the present application until almost two years after filing. These facts show that it is not applicant's fault that the claims in the later-filed

application issued first, and therefore, a two-way test should be applied, as explained in Braat and Berg.

It may be that claims in a later-filed application issue before claims in an earlier-filed application simply because more time is required to determine the patentability of the earlier-filed claims. Any such delay, however, is not applicant's fault; rather, it is simply the result of the administrative process. The Federal Circuit recognized in Braat, 937 F.2d at 593, 19 USPQ2d at 1292, that applicant "should not be penalized by the rate of progress of the applications through the PTO," and therefore, any delay resulting from the administrative process is properly credited to the Patent Office. The Examiner, however, said: "It should be noted that normal prosecution of an application does not constitute delaying." (Office action, 10.) Applicant is not sure what the Examiner means by this statement. Applicant agrees that normal prosecution does not constitute delay caused by applicant. However, if a later-filed application issues before an earlier-filed application through normal prosecution, then there is delay and that delay should be credited to the Patent Office because it occurred through no fault of the applicant.

For all these reasons, a two-way obviousness test should be applied. Under that test, the present double patenting rejection is improper and should be withdrawn because the cited claims include limitations that distinguish and are not obvious over claims 25, 26, and 36-38 in the present application.

Applicant also points out that the policy behind an obviousness-type double patenting rejection is "to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later." In re Berg, 140 F.3d at 1431-

1432, 46 USPQ2d at 1229. This is not a concern in the present application because patent term is now measured from the filing date rather than the issue date. 35 USC 154(a)(2).

Applicant further points out that this double patenting rejection of earlier-filed claims is inconsistent with the practice of filing continuation-in-part applications. The rejection, if correct, would mean that a subsequent invention comprising A, B and C could be the basis for a double patenting rejection of a previous invention comprising only A and B even though the subsequent invention could not have been included in the prior application because it had not yet been invented and even though the claims to the subsequent invention could not be added to the earlier application because those claims would constitute new matter. The result would be to unfairly limit the ability of an inventor to file applications on subsequent inventions, which is contrary to the ruling of Braat discussed above.

This double patenting rejection also results in unequal treatment under the patent laws. Specifically, this double patenting rejection prevents applicant from receiving separate patents to genus and species inventions simply because one application includes claims that dominate claims in the other application, even though others could obtain separate patents. For example, if a third party invented the machine described in the cited claims instead of applicant, then both applicant and the third party could patent their respective inventions without receiving a double patenting rejection even though the claims to the genus would dominate the claims to the species. If unrelated parties can file separate applications to genus and species claims without invoking a double patenting rejection, then a single party should be able to do likewise.

Applicant also asserts that even under the one-way test, the double patenting rejection should be withdrawn because claims 25, 26 and 36-38 do not define merely an obvious variation of the invention defined by cited claims 1, 4, 5, 7 and 20-35. Claims 25 and 26 require a "a base configured to rest on a generally horizontal surface to support the saw during operation," "a work surface supported by the base above the generally horizontal surface on which a workpiece may be cut," and "a reaction system ... configured to use at least a fraction of the angular momentum of the blade to generate a force tending to urge the axis around which the blade rotates away from the work surface when the blade decelerates the blade." Claim 26 further specifies that the "brake is configured to stop the rotation of the blade." Claims 36-38 require "a brake mechanism including at least one braking component configured to engage the cutting tool upon detection of at least one of the dangerous conditions by the detection system, where engagement of the braking component with the cutting tool tends to urge the cutting tool in a direction away from the cutting region." The cited claims do not include these limitations. Additionally, the cited claims include limitations not found in the cited claims of the present application and those limitations result in claims that define an invention patentably distinct from the claims in the present application. See General Foods Corp. v. Studiengesellschaft Kohle mbH, 23 USPQ2d 1839, 1843 (Fed. Cir. 1992) ("Anything less than a process with all 9 steps is not what is claimed, and is, therefore, not patented."); In re Stanley and Lowe, 102 USPQ 234, 240 (CCPA 1954) (appealed claims were distinguishable from improvement claims because the improvement claims included additional limitations).

2. Application Number 10/051,782 combined with Yoneda.

The Examiner provisionally rejected claims 27, 29, 30, 39, 40 under the judicially created doctrine of obviousness-type double patenting in light of claims 1, 4, 5, 7 and 20-35 from application number 10/051,782 combined with Yoneda (US Patent No. 4,117,752).<sup>2</sup> The rejection of those claims is traversed for the same reasons explained above and because there is no motivation or suggestion to combine Yoneda with the cited claims.

3. Application Number 10/052,273.

The Examiner provisionally rejected claims 25, 26 and 36-38 under the judicially created doctrine of obviousness-type double patenting in light of claims 5, 8 and 15 from application number 10/052,273.<sup>3</sup> This rejection is traversed for the same reasons explained above in section 1.

4. Application Number 10/052,273 combined with Yoneda.

The Examiner provisionally rejected claims 27, 29, 30, 39, 40 under the judicially created doctrine of obviousness-type double patenting in light of claims 5, 8 and 15 from application number 10/052,273 combined with Yoneda. This rejection is traversed for the same reasons explained above in section 1 and because there is no motivation or suggestion to combine Yoneda with the cited claims.

5. Application Number 10/643,296.

The Examiner provisionally rejected claims 25-27, 29, 30 and 36-40 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-10

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<sup>2</sup> Application 10/051,782 has now issued as U.S. Patent No. 6,877,410.

<sup>3</sup> Application 10/052,273 has now issued as U.S. Patent No. 6,813,983.

from application number 10/643,296. This rejection is traversed for the same reasons explained above in section 1.

### **Claim Rejections – 35 USC 103**

Claims 36 and 38-40 were rejected under 35 USC 103(a) as obvious in light of Boston et al. (U.S. Patent No. 5,285,708) or Meredith (U.S. Patent No. 5,724,875) in view of Lokey (U.S. Patent No. 3,785,230) and Friemann et al. (U.S. Patent No. 3,858,095) or Yoneda (U.S. Patent No. 4,117,752) and Terauchi (U.S. Patent No. 4,512,224). This rejection is traversed.

Claims 36 and 38 describe a woodworking machine with a braking component configured to engage a cutting tool. The claims specify that the “engagement of the braking component with the cutting tool tends to urge the cutting tool in a direction away from [a] cutting region.” None of the cited references discloses this limitation, and therefore, claims 36 and 38 cannot be obvious in light of the cited references. MPEP 2143.03.

Boston and Meredith disclose miter saws without any braking system. Lokey discloses a hand-held saw and a table saw with braking systems, and Friemann and Yoneda disclose band saws with braking systems. None of the braking systems disclosed in these references, however, teach or suggest a braking component configured so that engagement of the braking component with the cutting tool tends to urge the cutting tool in a direction away from a cutting region. The Examiner relies on Terauchi to teach or suggest this

limitation. Specifically, the Examiner says: "Terauchi discloses that it is old and well known in the art to use safety systems that include immediate stopping of the blade or retraction of the blade when the blade contacts a workpiece holder for the purpose of preventing damage or further damage to the workpiece holder." (Office action, 7.) Terauchi also fails to disclose that limitation.

Terauchi discloses a slitter machine to cut material such as cotton cloth that is rolled onto a tube. The roll is held horizontal and a blade moves forward to cut the roll. The blade will advance until a limit switch contacts a stop, at which point the blade will move back. If the limit switch fails, then the blade will continue to move forward without stopping until it contacts the rod supporting the roll. If that contact occurs, a current will pass from the blade through the rod to signal the blade to move back and/or stop. Terauchi uses a motor M1 to turn a screw 11 to move the blade forward and back, and it uses an electromagnetic brake to stop the rotation of the blade.

Terauchi fails to disclose or suggest a brake component configured so that engagement of the braking component with the cutting tool tends to urge the cutting tool in a direction away from a cutting region. In fact, nothing in Terauchi engages the blade at all. Instead, the blade in Terauchi rides on a table supported by a screw, and the screw turns in one direction to move the blade forward to cut the cloth roll and it turns in the other direction to move the blade back. Turning the screw is the only way to move the blade. The teaching that the screw can move the blade back does not suggest a brake component as configured in applicant's claims 36 and 38 because the screw does not engage

the blade. Additionally, there is no way to physically combine the screw from Terauchi with the brakes disclosed in Lokey, Friemann or Yoneda. Perhaps more importantly, even if one could combine the teachings from Terauchi with the brakes disclosed in the other cited references, the combination still would not result in a device as set forth in applicant's claims because no reference discloses a brake component tending to urge the cutting tool away due to engagement with the cutting tool. Therefore, claims 36 and 38 are not obvious.

Terauchi should not even be considered in an obviousness inquiry because it is non-analogous art and therefore outside the proper scope and content of the art. MPEP 2141.01(a). Terauchi is non-analogous art because it is outside the field of applicant's endeavor. The field of applicant's endeavor was woodworking machinery while the field of Terauchi's disclosure was textile cutting, specifically, slitters used to cut cloth rolled onto a tube. Terauchi is also non-analogous art because it is not reasonably pertinent to the particular problem addressed by applicant's claims. Applicant's claims 36 and 38 address the problem of detecting a dangerous condition between a person and a cutting tool and then urging the cutting tool away from the cutting region when the dangerous condition is detected. Terauchi addresses the issue of a blade that fails to stop when cutting through a roll of cloth. Nothing in Terauchi addresses or even mentions the problem of a dangerous condition between a person and the blade.

Claims 39 and 40 describe a miter saw with "a reaction system adapted to create an impulse against movement of the blade into the cutting zone upon detection by the detection system of contact between the person and the blade,

where the impulse is created due at least partially to the angular momentum of the blade." Claim 40 further specifies that "the reaction system includes a brake mechanism adapted to engage the blade, and where the engagement of the brake mechanism with the blade creates the impulse against movement of the blade into the cutting zone." None of the cited references suggest using at least a part of the angular momentum of the blade to create the impulse against movement, and clearly none of the references teach or suggest creating that impulse through engagement of a brake mechanism with the blade. Therefore, claims 39 and 40 cannot be obvious in light of the cited references. MPEP 2143.03.

**Allowable Subject Matter**

Applicant notes that the only rejections of claims 25-27, 29 and 37 are the double patenting rejections, but those rejections should be withdrawn for the reasons given above. Accordingly, claims 25-27, 29 and 37 should be allowable.

**Withdrawn Claims**

Applicant requests that withdrawn claims 28 and 35 be reinstated because they depend from claims 27 and 25, respectively, and claims 27 and 25 should now be allowable.

Conclusion

Applicant submits that all of the issues raised in the Office action mailed December 17, 2004 have been addressed and overcome, and therefore, the application should be allowed.

Respectfully submitted,

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